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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,190	12/22/2000	Timo Kinnunen	042933/301932	8071

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/742,190	KINNUNEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lisa Hashem	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. In view of the Pre-Appeal Brief Request filed on 3-7-2006, PROSECUTION IS HEREBY REOPENED. Non-Final action is set forth below.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5-8, 10, and 12- 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,351,763 by Kawanaka in view of U.S. Patent No. 6,385,305 by Gerszberg et al, hereinafter Gerszberg.

Regarding claim 1, Kawanaka discloses a communication device (Fig. 1, 1) including a messaging user interface (col. 4, line 60 – col. 5, line 25), the interface including means for entering text for inclusion in a message (Fig. 2, 204; col. 5, lines 16-20), means for selecting at least one of time, date, and location conditions under which the message may be opened by a device of a recipient (col. 1, lines 10-15; col. 1, lines 55-61; col. 4, lines 41-46; col. 4, lines 54-56; col. 4, line 60 – col. 5, line 20; col. 5, lines 50-55; col. 6, lines 3-6) and means for storing said message together with a message header (e.g. the designated date for opening and message A stored in message A1) holding the at least one of time, date, and location conditions under which the message may be opened by the device of the recipient (col. 4, lines 54-56; col. 4, line 60 – col. 5, line 31; col. 5, lines 50-55; col. 6, lines 3-6).

in a memory of a communication device (Fig. 1, 32; reception server) (col. 5, lines 35-56).

Kawanaka clearly discloses means for selecting a date condition under which the message may be opened by a device of a recipient. However, Kawanaka does not disclose means for selecting a component for inclusion in a message and means for storing in the communication device.

Gerszberg discloses a communication device (Fig. 5; Fig. 1: 10, 130; col. 3, lines 11-16) including  
a messaging user interface (Fig. 5),  
the interface including means for selecting a component (e.g. object) for inclusion in a message (col. 8, line 7 – col. 9, line 16; col. 11, lines 39-57),  
means for selecting at least one of time, date, and location conditions under which the message may be opened by a device (e.g. videophone-enabled telephone) of a recipient (e.g. caller) (col. 6, lines 42-57; col. 9, lines 17-30; col. 10, line 33 – col. 11, line 4) and  
means for storing said component as a message together at least one of time, date, and location conditions under which the message may be opened by the device of the recipient in the communication device (Fig. 3B, 173; col. 6, lines 38-41; col. 8, lines 7-12; col. 11, lines 39-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Kawanaka to include means for selecting a component for inclusion in a message and means for storing in the communication device as taught by Gerszberg. One of ordinary skill in the art would have been lead to make such a modification to provide an improved user interface capable of composing a message with a

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component that maybe include multimedia sources and to store the message locally on the communication device to provide a copy of the message that is sent to the recipient.

Regarding claim 5, a device as claimed in claim 1 mentioned above, wherein Gerszberg further discloses the message includes a plurality of components and associated presentation files (col. 8, line 7 – col. 10, line 5).

Regarding claim 6, a device as claimed in claim 1 mentioned above, wherein Gerszberg further discloses in which at least one component is a multimedia file (col. 8, line 7 – col. 10, line 5).

Regarding claim 7, a device as claimed in claim 1 mentioned above, wherein Gerszberg further discloses including means for creating a presentation file associated with said component, said file being stored with said message (col. 8, line 7 – col. 10, line 5; col. 11, lines 39-57).

Regarding claim 8, a device as claimed in claim 7 mentioned above, wherein Gerszberg further discloses the presentation file contains parameters relating a size and position of a component comprising a video image (col. 8, lines 7-53).

Regarding claim 10, a device as claimed in claim 7 mentioned above, wherein Gerszberg further discloses the presentation file contains parameters relating to a color and font of a component inherently comprising a text string (col. 8, lines 7-53).

Regarding claim 12, a device as claimed in claim 1 mentioned above, wherein Kawanaka further discloses including means for formatting the message as an email (col. 1, lines 10-15; col. 1, lines 55-65; col. 5, lines 16-20).

Regarding claim 13, a device as claimed claim 1 mentioned above, wherein

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Gerszberg further discloses including wireless network interface means (col. 4, lines 35-48; col. 4, line 58 – col. 5, line 18).

Regarding claim 14, a device as claimed in claim 1, wherein Gerszberg further discloses the device is a radio telephone (e.g. a videophone that uses a radio frequency interface) (col. 4, lines 35-44; col. 4, line 58 – col. 5, line 18; col. 5, lines 24-30).

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanaka in view of Gerszberg as applied to claim 1, and in further view of U.S. Patent No. 5,781,186 by Jennings.

Regarding claim 2, a device as claimed in claim 1 mentioned above, wherein Kawanaka in view of Gerszberg do not disclose in which the message header further contains information descriptive of content of the message.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface including means for selecting a component for inclusion in a message, means for selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and means for storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses the message header further contains information descriptive of content of the message. (Fig. 2; col. 3, line 47 – col. 4, line 47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Kawanaka in view of Gerszberg to include the message header further contains information descriptive of content of the message as taught by

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Jennings. One of ordinary skill in the art would have been lead to make such a modification to provide the recipient with details of the components of the message.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanaka in view of Gerszberg as applied to claim 7, and in further view of Jennings.

Regarding claim 9, a device as claimed in claim 7 mentioned above, wherein Gerszberg further discloses the presentation file contains a component comprising an audio recording (col. 8, lines 33-49).

Kawanaka in view of Gerszberg do not disclose parameters relating to a volume of an audio recording.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface including means for selecting a component for inclusion in a message, means for selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and means for storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses the presentation file inherently contains parameters relating to a volume of a component comprising an audio recording (col. 1, lines 11-30; col. 4, line 48 – col. 5, line 34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Kawanaka in view of Gerszberg to include parameters relating to a volume of an audio recording as taught by Jennings. One of ordinary

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skill in the art would have been lead to make such a modification to allow a sender to modify or adjust the volume of the audio recording before sending it to a recipient.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanaka in view of Gerszberg as applied to claim 1, and in further view of Jennings.

Regarding claim 11, a device as claimed in claim 1 mentioned above, wherein Kawanaka in view of Gerszberg do not disclose means for formatting the message as an attachment to a short text message.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface including means for selecting a component for inclusion in a message, means for selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and means for storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses means for formatting the message as an attachment to a short text message (see Abstract; col. 5, lines 35-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Kawanaka in view of Gerszberg to include means for formatting the message as an attachment to a short text message as taught by Jennings. One of ordinary skill in the art would have been lead to make such a modification to allow a sender to attach the message to a short text message.

***Response to Arguments***



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7. Applicant's arguments with respect to claims 1, 2, and 5-14 have been considered but are moot in view of the new ground(s) of rejection.

8. Accordingly, this action is **NON-FINAL**.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent Application Publication No. 2004/0014459 by Shanahan discloses a means for selecting at least one of time and date conditions under which a message may be opened by a device

10. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300 (for formal communications intended for entry)

**Or call:**

(571) 272-2600 (for customer service assistance)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or

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relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh

June 20, 2006

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600